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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,408	07/18/2003	John Michael Edison	21348	2820

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EXAMINER

J. LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2131

MAIL DATE	DELIVERY MODE
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06/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/621,408

Applicant(s)

EDISON ET AL.

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 26 March 2007 has been noted and made of record.
2. Claims 1-17 have been presented for examination.

Response to Arguments

3. Applicant's amendments with respect to claim 10 has been fully considered and is persuasive. The objection of claim 10 has been withdrawn
4. Applicant's amendments with respect to claims 2 and 7 have been fully considered and are persuasive. The 35 U.S.C. 112, 2nd rejection of claims 2 and 7 has been withdrawn. Contrary to the Applicant's statement on page 5 of the amendment of 26 March 2007, claim 6 has not been amended and the 35 U.S.C. 112, 2nd rejection of claim 6 is upheld.
5. Applicant's arguments regarding the prior art rejection of claim 1-17 filed 26 March 2007 have been fully considered but they are not persuasive.
6. Applicant's arguments regarding claims 1 and 8 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Applicant fails to point out with specificity to column and line number of the prior art how the claim language of the instant application is different.
7. In response to applicant's argument that Lawrence does not determine whether a prospective vendor to whom a client may be entertaining outsourcing certain work involving confidential information, is qualified under government regulations to handle such confidential information, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

8. In response to applicant's argument regarding claims 1 and 8 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, such as determining whether a prospective vendor to whom a client may be entertaining outsourcing certain work involving confidential information, is qualified under government regulations to handle such confidential information, are not recited in the rejected claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. In response to the Applicant's arguments regarding claims 1 and 8 that Lawrence does not teach determining whether a prospective vendor to whom a client may be entertaining outsourcing certain work involving confidential information, is qualified under government regulations to handle such information, the Examiner disagrees. Lawrence discloses at paragraph 0014 that the present invention manages risk associated with government regulations, which includes gathering data relevant to regulation from multiple sources and aggregating the data according to risk variables. The risk variables are partially defined in paragraph 0034 as being related to information gathered from lists that are generated by government agencies, such as the U.S. Commerce Department. This is further supported by the last sentence of paragraph 0013 which states "[the] risk information...[can] be conveyed to a compliance department and be able to demonstrate to regulators that a financial institution has met standards relating to risk containment."

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10. Since Lawrence teaches determining whether a prospective vendor to whom a client may be entertaining outsourcing certain work involving confidential information, is qualified under government regulations to handle such information as shown above, the rejection is maintained.

11. See further rejections that follow.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the vendor." There is insufficient antecedent basis for this limitation in the claim, and the Examiner will construe "the vendor" to be the "second parties" disclosed in claim 1.

Claim Rejections - 35 USC § 102

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 1-4, 8, 11, and 13-15 are rejected under 35 U.S.C. 102(a) and 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0138417.

16. As per claim 1, Lawrence teaches a transaction involving a disclosure of confidential information by first parties to second parties (paragraph [0014], i.e. financial transaction), requiring the second parties to adopt security measures with respect to the handling of the information and periodically respond to requests of the first parties for assurances of the

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implementation and observance of the security measures (paragraphs [0002], [0016], [0017]), a method for providing the assurances to the first parties, comprising:

arranging with a selected number of the second parties to acquire, compile and store in a database information regarding the adoption, implementation, and observation of security measures for each of the selected number of second parties (Figures 3 [block 312], 4 [block 410], paragraphs [0031], [0079], i.e. gathers and stores information in a database related to a risk assessment of a party involved in a financial transaction);

arranging with a selected number of the first parties subscription services providing the selected number of first parties with assurances of the security measures of the selected number of second parties upon request (Figures 1 [block 111], 2 [blocks 220, 221], paragraphs [0035], [0037], [0067], i.e. subscriber's request for information); and

providing the assurances of the security measures of the selected number of second parties to the selected number of first parties upon request (Figures 3 [block 319], 4 [block 418], 5 [block 517] paragraph [0013], [0031], [0032], [0088], [0091], [0097], i.e. convey that a financial institution complies with government standards relating to risk containment, scrubbed and augmented data is transmitted to a subscriber that relates risk variable involved in a financial transaction).

17. Regarding claims 2 and 13, Lawrence teaches updating the security measures information stored in the database for each second party periodically (paragraphs [0079], [0094], i.e. ongoing monitoring).

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18. Regarding claim 3, Lawrence teaches updating the security measures information stored in the database upon a notification by a respective second party (paragraphs [0031], [0039], i.e. a financial institution can integrate a risk management clearinghouse) and verification by a third party (paragraph [0080], i.e. source of risk variable by other provider of risk management data, such as a government agency).

19. Regarding claims 4 and 11, Lawrence teaches wherein the acquisition, compilation and storage of the security measures information of the selected number of second parties is performed at no cost to the selected number of second parties (Figures 3 [block 312], 4 [block 410], paragraphs [0031], [0079], i.e. gathers and stores information in a database related to a risk assessment of a party involved in a financial transaction). Lawrence makes no mention of a cost, fee or surcharge associated with the accumulation of risk related data anywhere in the patent application.

20. As per claim 8, Lawrence teaches a method for providing security information on a plurality of vendors to a plurality of clients, comprising:

providing an assessment of security procedures adopted, implemented and observed for each of the plurality of vendors (Figures 3 [block 312], 4 [block 410], paragraphs [0031], [0079], i.e. gathers and stores information in a database related to a risk assessment of a party involved in a financial transaction);

storing each assessment in a vendor security database (Figures 1 [block 112], 2 [block 210], paragraphs [0031], [0042], [0043], [0054], [0058], [0060]);

providing access to the vendor security database to each client to allow each client to review the plurality of assessments (Figures 3 [block 319], 4 [block 418], 5 [block 517], paragraphs [0063], [0086], i.e. a subscriber will be able to access the database).

21. Regarding claim 14, Lawrence teaches wherein the assessment is updated whenever the vendor updates its security procedures, the updates are verified and provided to the VMS (paragraphs [0093], [0094], i.e. RMC monitors for and stores updates).

22. Regarding claim 15, Lawrence teaches wherein each assessment comprises one or more of SAS70 reports, Penetration Reports, Information Security Policies, Computer Incident Response Policies, DR Plans, Business Resumption Plans, Insurance Coverages, 3rd Party Vendor Management Policies & Programs and Annual Financial Reports (paragraphs [0003]-[0005], [0008], [0017], [0035], i.e. SAS 70 reports include the suspicious activity reports disclosed in Lawrence).

Claim Rejections - 35 USC § 103

23. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

24. Claims 5-7, 9, 10, 12, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence in view of U.S. Patent Application Publication No. 2004/0193907 to Patanella, hereinafter Patanella.

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25. Regarding claims 5 and 12, Lawrence teaches wherein the access provided to each client is a subscription service (Figures 1 [block 111], 2 [blocks 220, 221], paragraphs [0035], [0037], [0067]).

26. Lawrence does not teach rendering the subscription services for a fee.

27. Patanella discloses a cost-effective method for assessing a network for compliance with a number of regulations, policies, or standards in paragraph [0008]. One of ordinary skill in the art would infer that since there is a cost associated with the method, therefore a fee could be charged to subscribers.

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to render the subscription services for a fee, since Patanella states at paragraph [0006] that the reporting capabilities of the previous system are immature and require highly technical personnel to analyze and make sense out of the results. Therefore, one of ordinary skill in the art would recognize the need for a subscription fee to pay the technical personnel to translate and present the reports to the users in a clear and concise manner.

29. Regarding claims 6, 7, 16 and 17, Lawrence does not teach providing a rating for each second party based upon a type of the confidential information and the security measures of the second party.

30. Patanella teaches providing a rating for each second party (Figure 7, paragraph [0017], i.e. low risk, medium risk, high risk, information risk) based upon a type of the confidential information (paragraphs [0069], [0070], i.e. compares to industry average, for example, for financial institutions) and the security measures of the second party (paragraphs [0017], [0069],

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[0070], i.e. defining the security levels, such as high risk refers to the system being compromised, that requires immediate attention).

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rating based upon confidential information and/or security measures of the vendor, since Patanella states at paragraph [0008] and [0069] that providing a rating allows the user to view the most vulnerable systems in a ranking that is cost-efficient and permits the user to see which systems require the most attention, as well as suggest possible fixes to patch certain vulnerabilities.

32. Regarding claims 9 and 10, Lawrence does not teach wherein the assessment is provided at cost or fee to the vendor.

33. Patanella discloses a cost-effective method for assessing a network for compliance with a number of regulations, policies, or standards in paragraph [0008]. One of ordinary skill in the art would infer that since there is a cost associated with the method, therefore some type of cost or fee could be charged to the vendor.

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to charge the vendor, since Patanella states at paragraph [0006] that the reporting capabilities of the previous system are immature and require highly technical personnel to analyze and make sense out of the results. Therefore, one of ordinary skill in the art would recognize the need for a charge to the vendor to pay the technical personnel to translate and present the reports to the users in a clear and concise manner.

Conclusion

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

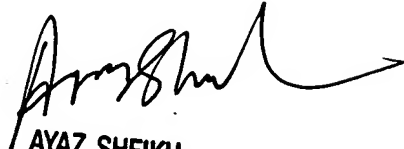
38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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